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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/456,157	12/07/1999	CARY LEE BATES	RO999-060	6052

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EXAMINER

HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 12/22/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/456,157

Applicant(s)

BATES ET AL.

Examiner

Cong-Lac Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: the application filed 12/7/99.
2. Claims 1-45 are pending in the case. Claims 1, 7, 10, 11, 15, 18, 23, 27, 35, 38, 41 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 10, 35-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter.

Regarding independent claim 10, the claim is directed to a paste buffer including a first field containing information selected by a user and a second field containing information relating to a source of the user-selected information. Since the paste buffer is merely a descriptive material and not functional, the paste buffer is considered as a non-statutory subject matter.

Claims 35-37 are for the program product of claim 10, and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 6-8, 10-13, 15-16, 18-21, 23-24, 26-32, 34-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinkelacker (US Pat No. 6,345,284 B1, 2/5/02, filed 6/6/97).

Regarding independent claim 18, Dinkelacker discloses:

- copying information selected by a user into the paste buffer (col 5, lines 1-13: the highlighted object is extracted and written to the buffer)
- automatically collecting and writing information relating to a source of the user selected information into the paste buffer when the user-selected information is copied into the paste buffer (col 4, line 60 to col 5, line 13: the Palette Manager passes any tags, attributes or file names selected by user through the user events and any tags and attributes that the user attaches to the extracted object are written into the buffer, figure 7, #708, #701, #712, #702)

Dinkelacker does not disclose the first field and the second field in the paste buffer for copying information selected by a user and writing information relating to a source of the user selected information when the user-selected information is copied into the paste buffer.

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However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the following reason. The fact that Dinkelacker *has the capability to write the highlighted data selected by a user and the attribute or the file name attached to the extracted object to the buffer* shows that the buffer has designated portions to store the extracted information and the attributes or file name copied into the buffer and to support the retrieving process when writing said information to the destination files (col 5, lines 1-13). In other words, it is suggested to include in the buffer various fields for storing specific data differentiated by using the "first" and the "second".

Regarding claim 19, which is dependent on claim 18, Dinkelacker discloses that the information written to the paste buffer is determined by at least on specified cut/copy preference (col 3, line 56 to col 4, line 10 and figure 4: the information written to the buffer is determined by at least on specified cut/copy preference for example a user wants to present the selected text to either a novice, an expert, or want to attach the title or the author of the source with the selected text).

As mentioned in claim 18, Dinkelacker does not disclose that the buffer includes the second field for storing the information relating to the extracted text. However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a second field in the buffer for the same reason as mentioned in claim 18.

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Regarding claim 20, which is dependent on claim 18, Dinkelacker discloses:

- inserting the information in the paste buffer into a document (col 5, lines 1-13: writing the selected text in the buffer into the destination file)
- processing the information in the paste buffer to determine whether or not to automatically create a citation according to at least one specified paste preference (col 5, lines 1-13; col 4, lines 29-37 and figure 4: writing the *file names or attributes attached to the selected text* into the destination files where the user preferences in #401 and #407 of figure 4 determine how the selected text is presented in the destination document)
- providing events of instructional content, associated with the highlighted object, as embedding the user preference when pasting object to the destination file, where the events can be created by users (col 3, line 33 to col 4, line 10)

Dinkelacker does not disclose the first field and the second field in the buffer that store the selected text and the source of the selected text to be pasted into a destination document.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the reason mentioned in independent claim 18 above.

Dinkelacker also does not disclose automatically creating a citation according to the paste preference.

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However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include creating a citation according to the paste preference for the following reason. Dinkelacker provides the author name as well as the file name of the document source of the selected portion as the user preference for pasting. The information of the source of the selected text and the *possibility of event creation of users* Dinkelacker, therefore, suggests to create a citation in the destination file since a user *can include an event of creating a citation as desired* based on the author name and the file name (of the document) which are well-known as the elements of a citation.

Regarding claim 21, which is dependent on claim 18, Dinkelacker does not disclose that the citation comprises a parenthetical citation that is inserted in the document after the information in the first field that is inserted into the document.

However, Dinkelacker does suggest creating a citation based on the possibility that a user can create instructional events associated with the selected object as mentioned in claim 20 above.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to *include the event of creating a parenthetical citation for a selected object instead of a general citation* based on the possibility of creating a desired event.

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Regarding independent claim 23, Dinkelacker discloses:

- inserting the information in the paste buffer into a document (col 5, lines 1-13: writing the selected text in the buffer into the destination file)
- processing the information in the paste buffer to determine whether or not to automatically create a citation according to at least one specified paste preference (col 5, lines 1-13; col 4, lines 29-37 and figure 4: writing the *file names or attributes attached to the selected text* into the destination files where the user preferences in #401 and #407 of figure 4 determine how the selected text is presented in the destination document)
- providing events of instructional content, associated with the highlighted object, as embedding the user preference when pasting object to the destination file, where the events can be created by users (col 3, line 33 to col 4, line 10)

Dinkelacker does not disclose the first field and the second field in the buffer that store the selected text and the source of the selected text to be pasted into a destination document.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include a first field and a second field in the buffer for storing the selected information and the source of the selected information for the following reason. The fact that Dinkelacker has the capability to write the highlighted data selected by a user and the attribute or the file name attached to the extracted data to the buffer shows that the buffer has designated portions to store the extracted information and the attributes or file name and to support the retrieving

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process when writing such information to the destination files (col 5, lines 1-13). In other words, it is suggested to include in the buffer the different fields for storing specific data into the buffer.

Dinkelacker also does not disclose automatically creating a citation according to the paste preference.

However, it would have been obvious to an ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include creating a citation according to the paste preference for the following reason. Dinkelacker provides the *author name as well as the file name* of the document source of the selected portion as the user preference for pasting. The information of the source of the selected text and the *possibility of event creation of users* Dinkelacker, therefore, suggests to create a citation in the destination file since a user *can include an event of creating a citation as desired* based on the author name and the file name (of the document) which are well known as the elements of a citation.

Claim 24 includes the same limitations as in claim 21, and is rejected under the same rationale.

Regarding claim 26, which is dependent on claim 23, Dinkdelacker suggests that the information stored in the paste buffer relates to a source for the selected information copied into the buffer as mentioned in claim 23.

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Claims 27-32, 34 are for a program product of method claims 18-21 and 23-24, and are rejected under the same rationale.

Claims 1-4 are for a system of method claims 18-21, and are rejected under the same rationale.

Regarding claim 6, and its corresponding program product claim 34, Dinkelacker discloses that the cut/copy mechanism and the paste mechanism are different portions of the same copy/paste mechanism (col 1, lines 29-50).

Claims 7-8 are for an apparatus for performing method claims 20-21 and 23-24, and are rejected under the same rationale.

Claims 11-13 are for an apparatus for performing method claims 18-21 and 23-24, and are rejected under the same rationale.

Claims 15-16 include the limitations of claims 11-13, and are rejected under the same rationale.

Regarding independent claim 10, Dinkelacker discloses:

- a portion in the buffer that contains information selected by a user (col 5, lines 1-10: the fact that the highlighted object selected by a user is written to the buffer indicates that the buffer has a place to store the selected information)
- another portion in the buffer that contains information relating to a source of the user-selected information (col 5, lines 1-13: the fact that the tags and the attributes of the extracted object are also written to the buffer indicates that the buffer has another place to store the information related to the selected information)

Dinkelacker does not use the first field and the second field to store the selected information and the information related to the selected information as above. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Dinkelacker to include the first field and the second field in the buffer since the various portions in the buffer of Dinkelacker clearly suggest including the various fields in various portions in the buffer for storing different data using the "first" and the "second" for the differentiating purpose.

Claims 35-37 are for a program product of claim 10, and are rejected under the same rationale.

Claims 38-40 are for a program product of method claim 18 and system claim 1, and are rejected under the same rationale.

Claims 41-44 are for a program product of method claims 20-21, and are rejected under the same rationale.

7. Claims 5, 9, 14, 17, 22, 25, 33, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinkelacker as applied to claims 3 and 18 above, and further in view of Nielsen (US Pat No. 6,199,071 B1, 3/6/01, filed 4/1/97).

Regarding claim 22, which is dependent on claim 18, Dinkelacker does not disclose that the citation comprises a footnote citation comprising a footnote reference number and footnote text, wherein the footnote reference number is inserted in the document after the information in the first field that is inserted into the document, and wherein the footnote text is placed in a different location in the document.

Nielsen discloses that the citation comprises a footnote citation comprising a footnote reference number and footnote text, wherein the footnote reference number is inserted in the document after the information in the first field that is inserted into the document, and wherein the footnote text is placed in a different location in the document (col 6, line 29 to col 7, line 3; figure 4, #409, #411; col 11, line 58 to col 12, line 15; figures 9a-b).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined the Nielsen's footnote citation into the Dinkelacker's pasted information for the following reason. Nielsen discloses generating a footnote citation including a footnote reference number and footnote text where the footnote reference number is placed next to the text in the document that needs to be referred to

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and footnote text is placed in a different location in the document providing the advantage to utilize the *selected text pasted in the destination document as a particular text that needs to be referred to* for inserting the footnote reference number and to utilize the attributes and the file name *associated with the selected text* and pasted to the destination file as the information *referred from the footnote number*.

Claim 25 includes the same limitations as in claim 22, and is rejected under the same rationale.

Claims 33 and 45 are for a program product of method claim 22, and are rejected under the same rationale.

Claim 5 is for a system of method claims 22 and 25, and is rejected under the same rationale.

Claims 9 and 14 are for an apparatus for performing method claims 22 and 25, and are rejected under the same rationale.

Claim 17 includes the same limitation as in claim 14, and is rejected under the same rationale.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Chirokas et al. (US Pat No. 5,111,397, 5/5/92).

Lawrence et al. (US Pat No. 6,289,342 B1, 9/11/01, filed 5/20/98).

Deike et al. (US Pat No. 6,240,430, 5/29/01, filed 12/13/96).

De La Huerga (US Pat No. 6,272,505, 8/7/01, filed 7/7/98).

Ruberry et al. (US Pat No. 6,356,287, 3/12/02, filed 5/28/98).

Iwanmoto et al. (US Pat No. 6,532,474 B2, 3/11/03, filed 11/13/98).

Anonymous, Copying quotations without retyping, Computimes Malaysia, Nov 15 1999, page 1.

Campbell, Share text among multiple documents, PC World Online, Jun 1, 1999, page 1.

Anonymous, Use the right paste command option for formatting ease, Inside Microsoft Excel, Nov 1998, Vol. 5, pg 8, 8 pgs.

McCracken et al., Office 2000 : Worth the bother?, PC World Online, Mar 8, 1999, pg. 1.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9000.

clh
12/11/03


STEPHEN S. HONG
PRIMARY EXAMINER